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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/561,042 | 05/02/2006 | Shigeyoshi Nishino | 740709-546 | 1891 |
| 22204 7590 12/03/2008 NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128 | | | | |
| EXAMINER MOORE, SUSANNA | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1624 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,042

Applicant(s)

NISHINO ET AL.

Examiner

SUSANNA MOORE

Art Unit

1624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 4/23/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

3DETAILED ACTION

Applicant's argument, see Remarks, filed 8/18/2008, with respect to Office Action mailed 4/16/2008 have been fully considered. Some of the rejections have been withdrawn, others have been maintained, and some are new rejections or are new as a result of Applicant's amendments. Thus, this is a Final Office Action. In summary, claims 1, 3, 4, 6 and 13-15 are currently pending and under consideration. Claims 13-15 are new claims.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 4/23/2008 was in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: METHOD FOR PREPARING QUINAZOLIN-4-ONE COMPOUNDS.

Claim Objections

The objection of claim 9 because of the following informalities: said claim, which is dependent on claim 1, is not further limiting is **withdrawn** based on the cancellation of said claim.

This application contains claim 1, drawn to an invention nonelected without traverse in the paper of 3/17/2008. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01. Applicant elected Group (III), drawn to a method for preparing compounds of formula (I), wherein the fused ring forms quinazolinones. Thus, Applicant must limit claim 1 to quinazolines by limiting X^1 , X^2 , X^3 and X^4 to carbon only. Furthermore, the term "absent" in claim 1 only refers to when these substituents are nitrogen.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claims 9 and 10 under 35 U.S.C. 112, second paragraph, as being indefinite for the phrase "has the meaning as defined above" for many variables, is **withdrawn** based on the cancellation of said claim.

The rejection of claims 9 and 10 under 35 U.S.C. 112, second paragraph, as being indefinite for the phrase "does not participate in the reaction" for the R^8 variable is **withdrawn** based on the cancellation of said claim.

Claim Rejections - 35 USC § 102

The rejection of claims 1-7, 9 and 10 under 35 U.S.C. 102(b) as being anticipated by Gakhar et. al. (J. Indian Chem. Soc., 1987, 64, 373-375) is **withdrawn** based on the amendments.

Art Unit: 1624

The rejection of claims 1, 5-7, 9 and 10 under 35 U.S.C. 102(b) as being anticipated by Rad-Moghadam et. al. (J. Chem. Research, 1998, 11, 702-703) is withdrawn based on the amendments.

The rejection of claims 1-5, 7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Tobe et. al. (Bioorg. Med. Chem., 2003, 11, 383-391) is withdrawn.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 6 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishino et. al. (WO 03/051849, US equivalent 7232903 B2).

The reference teaches the process of making of compounds of formula (7), by reacting the compound of formula (6), the anthranilic acid, with the compound of formula (4), methyl orthoformate, in the presence of a compound of formula (2), ammonia in methanol, a polar solvent, see column 4, lines 42-51. The reaction is heated to 120° C for 2 hours. Thus, said claims are rendered obvious over Nishino et al.

The applied reference has a common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

Art Unit: 1624

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Rejections - 35 USC § 103

The rejection of claims 1, 3, 4, 6 and 13-15 are rejected under 35 U.S.C. 103(a) as being obvious over Nishino et. al. (JP 2003-212862) is **withdrawn** based on the remarks.

Double Patenting

The rejection of claims 1-7, 9 and 11 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7232903 is **withdrawn** based on the terminal disclaimer submitted.

The provisional rejection of claims 1-7, 9 and 11 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 6, 8, 9, 16-19, 33 and 34 of copending Application No. 10502734 is **withdrawn** based on the terminal disclaimer submitted.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSANNA MOORE whose telephone number is (571)272-9046. The examiner can normally be reached on M-F 8:00-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna Moore/

Examiner, Art Unit 1624

/Brenda L. Coleman/

Primary Examiner, Art Unit 1624